

REMARKS

Claims 15-62 were previously pending and are still pending and under examination in this application. No new matter has been added. Claims 15, 27, 39, 50 and 52 are amended. Support for this amendment can be found in the application as filed.

Priority

The Examiner indicated that the instant application was filed on 02/14/2006, which was a 371 of PCT/US04/28021, filed on 08/27/2004. Applicant submits that PCT/US04/28021 claims priority to U.S. provisional application serial No.: 60/581,254, filed on 06/18/2004, and to U.S. provisional application serial No.: 60/498,270, filed on 08/27/2003. This priority information is reflected in the preliminary amendment which was submitted by the Applicant to the USPTO on February 14, 2006.

Rejections under 35 U.S.C. §112, first paragraph

Claims 47-49 and 56-62 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that “the specification, while being enabling for inhibition of binding of melanin concentrating hormone receptor, does not reasonably provide enablement for [the] treat[ment] and prevent[ion of] any and all diseases mediated by this receptor.”

Claims 47-49 and 56-62 are directed to methods of inducing cytokine biosynthesis in an animal and not to methods for the treatment and prevention of diseases mediated by the melanin concentrating hormone receptor as asserted by the Examiner. Applicant believes that this rejection was not intended for the instant claims 47-49 and 56-62. Accordingly, withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is respectfully requested.

Rejections under 35 U.S.C. §102(e):

Claims 15-46 and 50-53 are rejected under 35 U.S.C. §102(e) as being anticipated by Lindstrom et al., WO 2005/0324846. Lindstrom claims priority to U.S. provisional application serial No.: 60/508,634, filed on 10/03/2003.

The instant application claims priority to U.S. provisional application serial No.: 60/498,270, filed on 08/27/2003. Therefore, Lindstrom is not prior art to the instant application. Accordingly, reconsideration and withdrawal of this rejection under 35 U.S.C. §102(e) is respectfully requested.

Claim Rejections - Obviousness-type double patenting

Claims 15-38, 46-49, and 52-62 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-13, 23-49, 55-75, 78-79, 81-87, 89-111 of Lindstrom et. al U.S. patent application No.: 2007/0060754.

Without conceding the correctness of the Examiner's position, Applicant defers substantive rebuttal until the conflicting claims of the above-identified copending application have been allowed.

Claim Rejections - Obviousness-type double patenting

Claims 15-62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of U.S. patent No. 7,163,947.

Applicant has amended the claims. As currently amended, claims 15-62 are patentably distinct from claims 1-60 of U.S. patent No. 7,163,947. Accordingly, withdrawal of this rejection under the judicially created doctrine of obviousness-type double patenting is respectfully requested.

Claim Rejections - Obviousness-type double patenting

Claims 15-62 are provisionally rejected under the judicially created doctrine obviousness-type double patenting as being unpatentable over claims 1-79 of Griesgraber et. al U.S. patent application No.: 2004/0176367. Without conceding the correctness of the Examiner's position, Applicant defers substantive rebuttal until the conflicting claims of the above-identified copending application have been allowed.

Rejections under 35 U.S.C. §103(a)

Claims 15-40, 42-46, and 50-55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Griesgraber et. al US 7,163,947.

Without conceding the correctness of the Examiner's position, Applicant believes that the claims as currently amended are not obvious in view of claims 1-60 of U.S. patent No. 7,163,947. Accordingly, withdrawal of this rejection under 35 U.S.C. §103(a) is respectfully requested.

Furthermore, on page 13 of the office action, the Examiner indicated that two compounds in Griesgraber were analogous to those of the instant claims. However, the two indicated compounds were not disclosed in U.S. provisional application serial No.: 60/453,128, filed March 7, 2003, which is the only application that Griesgraber claims priority to which has a filing date earlier than August 27, 2003, the priority date of the instant application.

Rejections under 35 U.S.C. §103(a)

Claims 15-40, 42-46, and 50-55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Griesgraber et. al U.S. patent application No.: 2004/0176367.

Without conceding the correctness of the Examiner's position, Applicant has amended the claims. As currently amended, claims 15-62 are patentably distinct from U.S. patent application No.: 2004/0176367. Accordingly, withdrawal of this rejection under 35 U.S.C. §103(a) is respectfully requested.

Furthermore, on page 15 of the office action, the Examiner indicated that two compounds in Griesgraber were analogous to those of the instant claims. However, the two indicated compounds were not disclosed in U.S. provisional application serial No.: 60/453,128, filed March 7, 2003, which is the only application that Griesgraber claims priority to which has a filing date earlier than August 27, 2003, the priority date of the instant application.

CONCLUSION

In view of the above arguments, Applicant believes the pending application is in condition for allowance. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the application in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time.

If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: March 16, 2009

Respectfully submitted,

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